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In re Application of:
M. Young Kim
Application Serial No.: 09/662,023
Filed: September 14, 2000
For: **METHOD FOR CHECKING DISK LOADING STATUS IN OPTICAL DRIVER**

DECISION
ON PETITION

This is a decision on the petition filed February 15, 2005 under 37 CFR § 1.181, requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the final Office action mailed August 27, 2004.

PERTINENT BACKGROUND

This application was filed September 14, 2000.

A first Office action was issued March 11, 2004 rejecting claims 1, 4, and 5 under 35 USC 112, 2nd paragraph where the phrase "by multi-stage" was not understood and were rejected as being unpatentable under 35 USC 103 over JP 60-136059 further considered with JP4- 19827 and Mitani et al., and also rejecting claims 2 and 3 as unpatentable under 35 USC 103 over the art applied to claims 1, 4, and 5, further in view of Aoyagi et al.

A response to the first Office action was timely filed and received in the Patent and Trademark Office (PTO) on June 14, 2004. Claims 1, 4, and 5 were amended to overcome the rejections. Furthermore, new claims 6 and 7 were added.

A second Office action was issued on August 27, 2004 with new grounds of rejection rejecting claims 1, 4, 5, 6, and 7 as being unpatentable under 35 USC 103 over Tonegawa et al. considered with JP 60-136059 and Scribner et al. The examiner held that the amendment necessitated the new grounds of rejection and made the second Office action Final.

On November 29, 2004, applicant filed an amendment after Final.

On December 23, 2004, the examiner mailed an Advisory Action providing reasons why the amendment after Final would not be entered; and addressing why the request for reconsideration failed to place the application in condition for allowance.

Petitioner seeks relief by filing a petition under 37 CFR 1.181 requesting the finality of the Final Office action of August 27, 2004 be withdrawn.

REGULATIONS AND PRACTICE

37 CFR § 1.113(a) states in part that:

> (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's or patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191) or to amendment as specified in § 1.116. ...

MPEP § 706.07(a) states in part that:

> Under present practice, second or any subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is (not) necessitated by applicant's amendment of the claims...

OPINION

Petitioner contends that the new grounds of rejection in the Office action were not necessitated by amendment. Petitioner argues that claims 1-4 were amended in an attempt to overcome the 35 USC 112, 2nd paragraph rejection and did not affect the scope of the claims in any way and that no attempt was made to overcome the prior art rejections under 35 USC 103.

A review of the amendment filed June 14, 2004 finds that the attorney did more amending that just responding to the 35 USC 112, 2nd paragraph rejection. For example, applicant added new language to claim 1 specifying "transmitting information to a host connected through an interface to the optical disk driver" (emphasis added to show added material). This newly added phraseology was not in response to the 35 USC 112, 2nd paragraph rejection. Furthermore, it is determined that the examiner's new grounds of rejection were made in order to address interfacing between a host and a sub-unit as now claimed.

This feature was not presented earlier and its addition to claim 1 necessitated changing the grounds of rejection as discussed above. Thus, it is proper under current Office practice to make the second Office action Final as provided for under 37 CFR 1.113 and MPEP 706.07(a).

CONCLUSION

For the above stated reasons, the petition to withdraw the finality of the Final Office action of August 27, 2004 is **DENIED**.

The three month shortened statutory period for response set forth in the Final Office action of August 27, 2004 continues to run from the date of November 15, 2004, as RESET in the decision

mailed February 4, 2005. Furthermore, a review of the file finds a Notice of Appeal was filed March 14, 2005. Therefore, the application is being retained in the Technology Center to await the filing of an Appeal Brief.

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Communications